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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/882,125 | 06/15/2001 | Assaf Govari | BIO-121 | 8635 |

7590 10/06/2004
PETER GALLOWAY
PADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

PATIDAR, JAY M

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2862

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,125

Applicant(s)

GOVARI, ASSAF

Examiner

Jay M. Patidar

Art Unit

2862

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. This communication is in response to applicants' amendment filed on July 12, 2004.

2. The disclosure is objected to because of the following informalities: The appendix referred to on pages 14,15,17 is improper. Table 1 can either be part of the specification or drawings but can not be an appendix.

Appropriate correction is required.

3. The abstract of the disclosure is objected to because the abstract does not set forth the nature and gist of the invention. e.g. The abstract does not set forth the subject matter claimed in claim 1.

Correction is required. See MPEP § 608.01(b).

4. Claims 1,2,20,22 are objected to because of the following informalities:

In claims 1,20, it is unclear at line 6 (claim 1) as to what type of signals a signal processor receives; how a signal processor is adapted to determine the temperature of the position sensor;

In claims 2,22, the subject matter of this claim is already in claims 1,20 respectively;

In claim 20, it is unclear as to how a magnetic material produces a magnetic field.

Appropriate correction is required.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants admitted prior art in view of Dlugos (6,229,300) and Adler et al. (5,381,090).

Applicants admitted prior art discloses a medical device comprising a body; a position sensor having a core; a winding circumferentially positioned around the core and a signal processor processing the signal from the position sensor to determine the location coordinates of the sensor (Note pages 1-4 of the specification). Applicants admitted prior art fails to show a core made of a Wiegand effect material and measuring the temperature from the resistance of the winding. Dlugos and Adler are cited to show these features. Dlugos

discloses a Wiegand wire for determining the position of the object wherein the Wiegand wire having a core and shell portion. Dlugos discloses a position sensor wherein the coil 22 is wound around the Wiegand wire that generates the position dependent output signal (Note Figs. 1-3). Adler is cited to show that it is known in the magnetic field art to determine the temperature from the resistance of the winding since temperature is dependent on the resistance of the coil (Note col. 2, lines 32-42). The materials copper, cobalt, vanadium, iron etc. are known in the art. The use of one of these materials for its suitability or making any device miniature would be within the level of ordinary skill in the art. Consequently, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of applicants admitted prior art in view of Dlugos and Adler to have included a core made from Wiegand material to provide the kind of switching response to the threshold magnetic field that produces a uniform and repeatable output pulse from a pickup coil to determine the position of the object and to measure the temperature of the sensing device.

6. The amendment filed on July 12, 2004 with respect to claims will not be entered since the claims presented in this amendment are different from the claims filed on November 8, 2003.

7. Applicant's arguments filed July 12, 2004 have been fully considered but they are not persuasive. Please note that the claims submitted by the applicant are different from the claims filed on November 8, 2003.

8. In response to applicant's argument that Dlugos and Adler are nonanalogous arts, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are directed to measuring apparatus. Therefore, one of ordinary skill in the art would look at any type of position sensors in any type of environment e.g. medical field in order to solve the problem. In response to applicant's argument regarding the field of endeavor i.e. medical device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the

prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., producing a substantially uniform voltage pulse) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

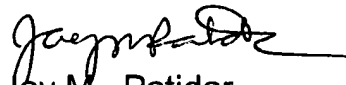
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay M. Patidar whose telephone number is 571-272-2265. The examiner can normally be reached on M-Thur 7:00-5:30.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jay M. Patidar
Primary Examiner
Art Unit 2862

September 30, 2004